

LAW OFFICES OF  
**PAUL, HASTINGS, JANOFSKY & WALKER LLP**

A LIMITED LIABILITY PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

600 PEACHTREE ST., N.E., STE. 2400  
ATLANTA, GEORGIA 30308-2222  
TELEPHONE (404) 855-2400

695 TOWN CENTER DRIVE  
COSTA MESA, CALIFORNIA 92626-1924  
TELEPHONE (714) 668-6200

TOWER 42  
25 OLD BROAD STREET  
LONDON EC2N 1HQ  
TELEPHONE (44) (20) 7562 4000

555 SOUTH FLOWER STREET  
LOS ANGELES, CALIFORNIA 90071-2371  
TELEPHONE (213) 683-6000

75 EAST 55TH STREET  
NEW YORK, NEW YORK 10022-3205

TELEPHONE (212) 318-6000

FACSIMILE (212) 339-9150

INTERNET [www.phjw.com](http://www.phjw.com)

ROBERT P. HASTINGS (1910-1996)  
COUNSEL  
LEE G. PAUL  
LEONARD S. JANOFSKY  
CHARLES M. WALKER

345 CALIFORNIA STREET  
SAN FRANCISCO, CALIFORNIA 94104-2635  
TELEPHONE (415) 835-1600

1055 WASHINGTON BOULEVARD  
STAMFORD, CONNECTICUT 06901-2217  
TELEPHONE (203) 961-7400

ARK MORI BUILDING  
12-32, AKASAKA 1-CHOME  
MINATO-KU, TOKYO 107, JAPAN  
TELEPHONE (03) 3586-4711

1299 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, D.C. 20004-2400  
TELEPHONE (202) 508-9500

January 29, 2001

WRITER'S DIRECT ACCESS

OUR FILE NO.

(212) 318-6055  
[jwkennedy@phjw.com](mailto:jwkennedy@phjw.com)

27827.00400

**Via Certified Mail - Return Receipt Requested**

Mr. John M. Whealan  
Office of the Solicitor  
United States Patent and Trademark Office  
P.O. Box 15667  
Arlington, Virginia 22215

**SOLICITOR**

**FEB 01 2001**

**U.S. PATENT & TRADEMARK OFFICE**

Re: *Purepac Pharmaceutical Co. v. Andrx Pharmaceuticals, Inc.*  
Civil Action No. 00-CV-1224

Dear Mr. Whealan:

This firm represents Purepac Pharmaceutical Co., the plaintiff, in the above-referenced action which is pending in the United States District Court for the Eastern District of Pennsylvania.

On Friday, January 26, 2001, the Court endorsed a Stipulated Order Modifying the Protective Order that had been entered in the action in order to permit Purepac to disclose to the PTO, on a confidential basis in accordance with § 724.02 of the MPEP, certain information relating to Purepac's pending Patent Application Numbers 09/606,629 and 09/447,642.

Paragraph 3 of the Stipulated Order requires that we serve a copy of the Stipulated Order upon you by certified mail, return receipt requested. Accordingly, a copy is enclosed. A copy of the Stipulated Order and the Protective Order it modifies will accompany Purepac's disclosure to the PTO.

If you wish to discuss this matter for any reason, please contact me.

Respectfully,

  
James W. Kennedy

of PAUL, HASTINGS, JANOFSKY & WALKER LLP

JWK:cmo  
Enclosure

cc: James V. Costigan, Esq.  
Dianne B. Elderkin, Esq.  
Steven Lee, Esq.  
Messrs. Graff and Bensen

ADDITIONAL NEW YORK OFFICE:

399 PARK AVENUE NEW YORK, NEW YORK 10022-4697

IN THE UNITED STATES DISTRICT COURT FOR THE  
EASTERN DISTRICT OF PENNSYLVANIA

RECEIVED

FEB 09 2001

TECH CENTER 1600/2000

PUREPAC PHARMACEUTICAL CO.

Plaintiff,

v.

ANDRX PHARMACEUTICALS, INC.

Defendant

Civil Action No. 00-CV- 1224

STIPULATED ORDER  
MODIFYING PROTECTIVE  
ORDER

FILED  
JAN 25 2001

MICHAEL A. HUNT, Clerk

The parties have entered into, and this Court has endorsed, a Stipulated Protective Order, dated June 26, 2000, governing discovery in this action; and

Section 9 of said Protective Order provides that the "Protective Order may be modified by further order of this Court or by agreement of the parties or their counsel, subject to the approval of the Court, provided that any such agreement be in the form of a stipulation that shall be filed with the Court and made a part of the record in this case;" and

Plaintiff having asked the Court to enter an order modifying the Protective Order in order to allow plaintiff's disclosure to the United States Patent and Trademark Office ("PTO"), in connection with the pending patent applications identified below, of certain information that defendant has designated under the Protective Order as Confidential or Confidential Attorney's Eyes Only; and

Defendants having opposed Plaintiff's request and Counsel for the parties having conferred with the Court by telephone concerning plaintiff's request; and

The Court having directed the parties to submit a stipulated order modifying the Protective Order to allow certain disclosure as set forth herein:

IT IS HEREBY STIPULATED AND AGREED by and between the undersigned counsel for the parties, and ORDERED, ADJUDGED AND DECREED by the Court, that

1. Notwithstanding any contrary confidentiality designation by defendant, the Protective Order is modified to allow Purepac's disclosure to the PTO, in connection with Purepac's pending patent application nos. 09/606, 629 ("629") and 09/447642 ("642"), of information, chosen by Purepac to be disclosed to the PTO pursuant to 37 CFR 1.56, contained in the notebooks of Chih-Meng Chen bearing production nos. 116295-480, 116482-613, 116615-74 and the transcript of the deposition testimony of Chih Meng Chen, dated November 17, 2000. In addition, so long as the '629 and '642 applications shall not have been canceled, withdrawn from consideration, issued or abandoned, plaintiff may also disclose to the PTO any and all information, chosen by Purepac to be disclosed to the PTO pursuant to 37 CFR 1.56, contained in additional testimony of Dr. Chen or any other of defendant's witnesses concerning Dr. Chen's notebooks or the experiments reflected in those notebooks. Prior to disclosure of such information, the plaintiff shall identify for defendant the specific portions of the aforementioned notebooks and transcripts plaintiff intends to disclose to the PTO.

2. The information described above shall only be disclosed in accordance with the provisions of Section 724.02 of the Manual of Patent Examining Procedure ("MPEP") governing the disclosure of material that is subject to a protective order, and shall be clearly labeled "Subject to Protective Order," as required by MPEP § 724.02. In addition to any other requirements of MPEP § 724.02, plaintiff shall provide the PTO with a copy of this Stipulated Order and the Protective Order it modifies, and shall advise the PTO that its disclosure of defendants'

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information is subject to the terms of this Stipulated Order and to the Protective Order. The PTO shall not exercise its authority, pursuant to 37 C.F. R. § 1.14 (see MPEP § 101), to release or make available to the public any of the information so disclosed and so labeled as Subject to Protective Order without first obtaining prior leave of this Court, on reasonable notice to the parties.

3. Prior to submission or disclosure of any documents by plaintiff to the PTO, plaintiff shall serve the Solicitor of the PTO with a copy of this order by certified mail, return receipt requested.

**RESPECTFULLY SUBMITTED:**

HOYLE, MORRIS &amp; KERR, LLP


By:



Stephen J. Mathes  
One Liberty Place, Suite 4900  
1650 Market Street  
Philadelphia, Pennsylvania 19103  
(215) 981-5700  
Attorneys for Plaintiff  
Purepac Pharmaceutical Co.

WOODCOCK WASHBURN KURTS  
MACKIEWICZ & NORRIS, LLP

By:



Thomas D. Smith  
One Liberty Place, 46<sup>th</sup> Floor  
Philadelphia, Pennsylvania 19103  
(215) 568-3100  
Attorneys for Defendant  
Andrx Pharmaceuticals, Inc.

**IT IS SO ORDERED:**

Dated: January 25, 2001

  
United States District Judge**ENTERED**

JAN 26 2001

CLERK OF COURT

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